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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,146	02/17/2004	Jason Victor Tsai	LeCr:Guide1	6027
53868	7590	05/09/2006	EXAMINER	
OSTER-LECROY Law Office of Karen Dana Oster, LLC 15450 SW BOONES FERRY RD., # 9 PMB 1020 LAKE OSWEGO, OR 97035			HOLLINGTON, JERMELE M	
			ART UNIT	PAPER NUMBER
			2829	
DATE MAILED: 05/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/781,146

Applicant(s)

TSAI ET AL.

Examiner

Jermele M. Hollington

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-14 and 17-28 is/are rejected.
- 7) ☒ Claim(s) 5-6 and 15-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

Base on the conversion with applicants' representative, the following is the new Office

Action.

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No.

10/975,769. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims in copending application covers the scope of the claims in this application. Furthermore, since both disclosures are similar, it would be obvious to include an adhesive in the claims of this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 7-11, 13-14, 17-22, 24-26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Barabi et al (6208155).

Regarding claim 1, Barabi et al disclose [see Fig. 2] a guide (test socket 11) for tip (probe tip 21) to transmission path contact (solder ball contact 43), said guide comprising at least one guide insulator (IC platform 25), at least one passageway (guide holes 27) defined by said at least one guide insulator (25), said at least one passageway (27) having a tip passageway end (bottom of hole 27) and a transmission path passageway end (top of hole 27); said tip passageway end (bottom of 27) suitable for at least partially accommodating said tip (21); said transmission path passageway end (top of 27) suitable for at least partially accommodating a transmission path (43); and said tip (21) contacting said transmission path (43) through said at least one passageway (27) when said transmission path (43) is positioned in said transmission path passageway end and said tip (21) is positioned within said tip passageway end.

Regarding claim 2, Barabi et al disclose said guide (25) facilitates relatively secure contact between said tip (21) and said transmission path (43).

Regarding claim 3, Barabi et al disclose said guide insulator (25) is removably interconnectable with a circuit board component having at least one transmission path (43).

Regarding claim 4, Barabi et al disclose said tip passageway end guides (top and bottom of 27) said tip (21) towards said transmission path (43).

Regarding claim 7, Barabi et al disclose said at least one guide insulator (25) is at least one divider guide insulator (frame wall 17).

Regarding claim 8, Barabi et al disclose said at least one guide insulator (25) further comprising a mounting apparatus (mounting spring 35) and at least one divider guide insulator (17).

Regarding claim 9, Barabi et al disclose said at least one guide insulator (25) further comprising a mounting apparatus (mounting spring 35) integral with at least one divider guide insulator (frame wall 17).

Regarding claim 10, Barabi et al disclose at least two guide insulators (25), said at least two guide insulators (25 and 17) being adjustable in relation to each other.

Regarding claim 11, Barabi et al disclose [see Fig. 2] a guide (test socket 11) for tip (probe tip 21) to transmission path contact (solder ball contact 43), said guide comprising a guide insulator (IC platform 25), at least one passageway (guide hole 27) defined by said at least one guide insulator (25), each passageway (27) having a passageway thickness, each passageway (27) having a tip passageway end (bottom of 27), said tip passageway end (bottom of 27) having a tip passageway end thickness, said tip passageway end suitable for at least partially accommodating a tip (21); each passageway having a transmission path passageway end (top of 27), said transmission path passageway end having a transmission path passageway end thickness, said transmission path passageway end suitable for at least partially accommodating said transmission path (43); and said tip (21) contacting said transmission path (43) through said

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at least one passageway (27) when said transmission path (43) is positioned in said transmission path passageway end and said tip (21) is positioned within said tip passageway end.

Regarding claim 13, Barabi et al disclose said transmission path passageway end (top of 27) is directly opposite said tip passageway end (bottom of 27).

Regarding claim 14, Barabi et al disclose said tip passageway end (bottom of 27) has an opening on a peripheral guide surface of said guide insulator (25).

Regarding claim 17, Barabi et al disclose including at least two passageways (27), said at least two passageways (27) being adjustable in relation to each other.

Regarding claim 18, Barabi et al disclose [see Fig. 2] a guide (test socket 11) for tip (probe tip 21) to transmission path contact (solder ball contacts 43), said guide (11) comprising: (a) at least one mounting apparatus (mounting spring 35), (b) at least one divider guide insulator (frame wall 17), said at least one divider guide insulator (17) mountable in said at least one mounting apparatus (35), (b) at least one passageway defined by said at least one divider guide insulator (17), (c) each passageway having a tip passageway end (bottom of 27), said tip passageway end suitable for at least partially accommodating a tip (probe tip 21); (d) each passageway having a transmission path passageway end (top of 27), said transmission path passageway end suitable for at least partially accommodating said transmission path (43); and (e) said tip (21) contacting said transmission path (43) through said at least one passageway when said transmission path (43) is positioned in said transmission path passageway end and said tip (21) is positioned within said tip passageway end (bottom of 27).

Regarding claim 19, Barabi et al disclose said at least one mounting apparatus (mounting spring 35) and said at least one divider guide insulator (frame wall 17) are integral.

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Regarding claim 20, Barabi et al disclose said at least one mounting apparatus (mounting spring 35) is divisible.

Regarding claims 21 and 25, Barabi et al disclose said transmission path (43) is positioned in said transmission path passageway end (top of 27) of said at least one guide insulator (25) before said tip (21) is positioned within said tip passageway end (bottom of 27) of said at least one guide insulator (25).

Regarding claims 22 and 26, Barabi et al disclose said transmission path (43) is positioned in said transmission path passageway end (top 27) of said at least one guide insulator (25), said guide insulator (25) provides general protection properties.

Regarding claims 24 and 28, Barabi et al disclose said guide insulator (25) has two passageways.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barabi et al (6208155).

Regarding claim 12, Barabi et al disclose said guide insulator (25) having tip passageways end (bottom end of 27). However, they do not disclose a funnel shaped opening or an enlarge, partial funnel shaped opening. It is well known to make the tip passageways end to any opening shape where needed (see MPEP 2144.04; In re Dailey, 357 F.2d 669, 149 USPQ 47

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(CCPA 1966)). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the tip passageways end to be funnel shape since the court held that the configuration of shapes was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed shape was significant.

Regarding claims 23 and 27, Barabi et al disclose said guide insulator (25) having passageways for the transmission paths (43) of the device (BGA device 41) to be probed. However, they do not disclosed the insulator having fewer passageways that the transmission paths. It is well known to make less passageways for an insulator than transmission paths where needed (see MPEP 2144.04; In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make fewer passageways for an insulator than transmission paths since it was held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

### ***Conclusion***

7. Applicant's arguments filed Dec. 22, 2005 have been fully considered but they are not persuasive.

1) The applicants' argue: *"The Barabi reference describes a completely different device in which the test socket is associated with the test probe, not the device to be tested... Barabi never contemplates the platform with the array of guide holes as an independent unit, but only as a unit in combination with the array of pogo pins. The Barabi platform with the array of guide holes, taken alone, would suffer from many of the same problems as the device described in U.S. Patent No. 6,281,695 to Chung, et al. (the "Chung reference") that was discussed in applicants' original specification. For example, one problem with the Barabi platform is that it must be made for*



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*each size and shape ball grid array to be tested... Still another problem with the Barabi platform is that it contacts all sides of the ball grid arrays to be tested, again limiting its ability to be used with different types of devices to be probed."*

In response to the above arguments, first, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Secondly, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Lastly, applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

***Allowable Subject Matter***

8. Claims 5-6 and 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

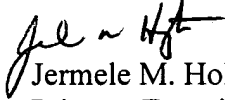
9. The following is a statement of reasons for the indication of allowable subject matter: regarding claims 5-6 and 15-16, the primary reason for the allowance of the claims is due to a guide comprising at least one passageway includes a contact enhancing mechanism.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermele M. Hollington whose telephone number is (571) 272-1960. The examiner can normally be reached on M-F (9:00-4:30 EST) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (517) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jermele M. Hollington  
Primary Examiner  
Art Unit 2829

JMH  
May 4, 2006